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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/821,264 | 04/09/2004 | Gregg S. Baker | 1220.0013-01 | 8615 |
| 22852 | 7590 | 10/23/2006 | EXAMINER | |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | AFTERGUT, JEFF H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1733 | |

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/821,264 | Applicant(s) BAKER, GREGG S. | |
| | Examiner Jeff H. Aftergut | Art Unit 1733 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-64, 66-76 and 78-84 is/are pending in the application.
- 4a) Of the above claim(s) 68, 69, 71, 72, 80, 81, 83 and 84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-64, 66, 67, 70, 73-76, 78, 79 and 82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Claims 68, 69, 71, 72, 80, 81, 83, and 84 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11-30-06.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 61-64, 66-67, 70, 73-76, 78-79 and 82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The applicant has amended each of the independent claims to recite that the adhesive employed in the process of attaching the bracket to the helmet was a "binary methyl methacrylate adhesive". The applicant alleges support for this can be found in paragraph [0056] of the disclosure where an "example of a suitable adhesive is DP810, which can be obtained from 3M Corporation." However the applicant has failed to provide evidence that "DP810" was in fact a known binary methyl methacrylate adhesive" at the time the invention was made. In fact, the 3M Scotch-Weld Low Odor Acrylic Adhesive identified from the enclosed Data Sheet from June 2004 (not available

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as evidence of the specific make up of the adhesive at the time of applicant's invention but actually dated subsequent to the filing of the application) states that the DP810 is a two part structural adhesive which is an acrylic adhesive (no mention of methyl methacrylate). As such, applicant's disclosure of the specific adhesive employed is deemed to be new matter, as the original disclosure did not support the specific "binary methyl methacrylate" as recited. Applicant must provide evidence of the nature of the make up of the DP810 employed and definition of the same in generic terms of the same and recite the generic terminology for the trade name in the claim in order to evidence that applicant was in fact in possession of the invention at the time of filing the same.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 61-64, 66-67, 70, 73-76, 78-79 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keim in view of Japanese Patent 2001-355118, the admitted prior art, Scotch-Weld Epoxy Adhesive 1838 B/A Green, 1838 B/A Tan, 1838-L B/A Translucent (May 1995) and 3m Adhesives 2003 Industrial Products Guide (newly cited).

The references to Keim, Japanese Patent '118, the admitted prior art, and Scotch-Weld Epoxy Adhesive 1838 B/A Green, 1838 B/A Tan, 1838-L B/A Translucent are cited for the same reasons as previously presented. It should be noted that in Keim the bracket was attached to the exterior of the helmet and that while the helmet was

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useful as a sports helmet in a high impact sport it would have been understood that various restraint systems were known per se in the art for vehicle helmets as noted by the applicant's admitted prior art and the use of the helmet of Keim as a vehicle helmet to prevent neck injuries would have been obvious. Use of an epoxy resin to attach the bracket to the helmet was art recognized as eliminating the need for drilling holes in the helmet as expressly suggested by Japanese Patent '118. the reference to Scotch-Weld Epoxy Adhesive 1838 B/A Green, 1838 B/A Tan, 1838-L B/A Translucent clearly suggested that epoxy resins (adhesives) were known structural adhesives having the specified properties identified. The combination provided no indication that one skilled in the art would have employed a structural adhesive which was an acrylic structural adhesive for joining the bracket to the helmet.

3M Adhesives Industrial Products Guide 2003 evidenced that as a known alternative structural adhesive material one skilled in the art at the time the invention was made would have understood that not only was 3M Scotch-Weld 1838 a known structural adhesive but that 3M Scotch-Weld DP810 was also a known structural adhesive for joining as an alternative to mechanical or fusion fastening (see pages C17, C26 and C10-C11. clearly, one versed in the art would have understood that DP810 was a suitable alternative structural adhesive material to that of Epoxy 1838 adhesive from 3M. Where as here two equivalents were known for their same desired function an express teaching of the substitution of one for the other is not needed to render such substitution obvious, see In re Fout, 213 USPQ 532, In re Siebentritt, 152 USPQ 618. It should be noted that there is no unexpected benefits derived from the use of the

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specified structural adhesive over the use of the structural epoxy adhesive. Additionally, the benefit of using the adhesive to form the joint was recognized by Japanese Patent '118 where there is no need to drill a hole in the helmet in order to reduce the strength of the same in making the safety helmet. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the DP810 Structural Acrylic adhesive from 3M Adhesives Industrial Products Guide 2003 as the adhesive for joining the bracket to the exterior of the helmet as such was an art recognized equivalent structural adhesive to the 1838 Scotch-Weld Adhesives from 3M taught by Scotch-Weld Epoxy Adhesive 1838 B/A Green, 1838 B/A Tan, 1838-L B/A Translucent as epoxy adhesives were known for attachment of a bracket to a helmet without the need for drilling into the helmet for mechanical fastening as taught by Japanese Patent '118 wherein the helmet would have been understood to have been useful as a vehicle helmet for motorcycle or vehicle racing as such helmets were known to be used in such environment as taught by the admitted prior art wherein a bracket was attached to the helmet with a suitable adhesive material as taught by Keim.

Applicant is referred to paragraph 9 of the previous Office action for a detailed description of the previously cited references.

Response to Arguments

6. Applicant's arguments with respect to claims 61-64, 66-67, 70, 73-76, 78-79 and 82 have been considered but are moot in view of the new ground(s) of rejection.

The applicant argues that the reference to Keim failed to teach that the bracket was attached to the helmet with a binary methyl methacrylate adhesive. As noted above

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the use of this definition for the trade name DP810 is unsupported in the original disclosure and additionally it is not supported by the data sheet obtained from 3M cited herein. It is suggested that applicant supply a data sheet (technical sheet) which clearly identifies DP810 as being a binary methyl methacrylate adhesive material.

As noted above with reference to 3M Adhesives Industrial Products Guide 2003 the use of the specified adhesive DP810 would have been an art recognized functionally equivalent structural adhesive for the structural epoxy adhesive suggested in the rejection. The original disclosure provides no insight as to an unexpected benefit from using the specified structural adhesive. The benefit obtained by practicing the process is that the use of adhesive to attach the bracket rather than a mechanical connection, eliminated the need for drilling a hole in the helmet which would have damaged and or reduced the effectiveness of the same (and prevented certification of the helmet for use by vehicle drivers). This benefit was realized by Japanese Patent '118 which suggested the use of an adhesive such as an epoxy adhesive to attach a bracket to a helmet without having to mechanically secure the same with a hole being formed via drilling in the helmet.

The applicant is advised that one skilled in the art at the time the invention was made viewing the background of the invention was well as Keim that the helmet assembly of Keim would have been useful for a vehicle helmet. Additionally one skilled in the art would have readily appreciated that the helmet was unaltered by drilling and/or piercing whereby it's certification would remain intact. It was well known that these helmets regularly receive certification and it was additionally intrinsic to such

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certification that one not alter the body of the helmet (because otherwise one skilled in the art would have not been able to retain the certification of the helmet). Note that the application of the bracket does not alter the structure of the helmet.

No claims are allowed.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeff M. Aftergut
Primary Examiner
Art Unit 1733

JHA
October 19, 2006